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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
INMEP0105US

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on February 23, 2006

Signature

Typed or printed name M. David Galin

Application Number	Filed
10/036,628	December 31, 2001

First Named Inventor: JianMin Wu

Art Unit	Examiner
2195	Syed J. Ali

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____.

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 41,767

Signature

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Typed or printed name

216-621-1113
Telephone number

February 23, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of one forms are submitted.

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REASONS FOR PRE-APPEAL BRIEF REVIEW

In the Advisory Action mailed February 1, 2006, the "Examiner concedes that Kung does not teach or suggest [the claimed] 'daisy chain' method of forwarding call requests." The only issue remaining from the Office Action mailed October 31, 2005 is a rejection of the claims under 35 U.S.C. § 102 over Kung (U.S. Patent No. 6,570,855). But if the Examiner concedes that the only applied reference does not teach or suggest that which is claimed, the application should be allowed.

Instead of allowing the application, the Examiner has appeared to introduce a new legal standard for patentability. Namely, "before the claimed invention can be said to be patentably distinct from Kung, it must be apparent that the claims are distinct from Kung." Applicants' undersigned representative is unaware of any support for such a patentability standard in the Patent Act or related case law.

The Examiner also states that certain claimed features are "superfluous." It is submitted that positively recited claim elements cannot be regarded as superfluous when evaluating patentability.

It should be readily apparent that the continued rejection of the application is clearly not proper and is without legal basis. In addition to the legal deficiencies in the maintenance of the rejection, there are also clear factual deficiencies.

The Examiner contends that "Kung teaches a workload amelioration method that is practically identical" - presumably to the claimed subject matter.

This statement has a logical failing if the Examiner also concedes the fact that Kung does not teach or suggest the claimed invention.

This statement is also factually incorrect. Kung discloses a different technique for ameliorating high workload situations than the claimed approach.

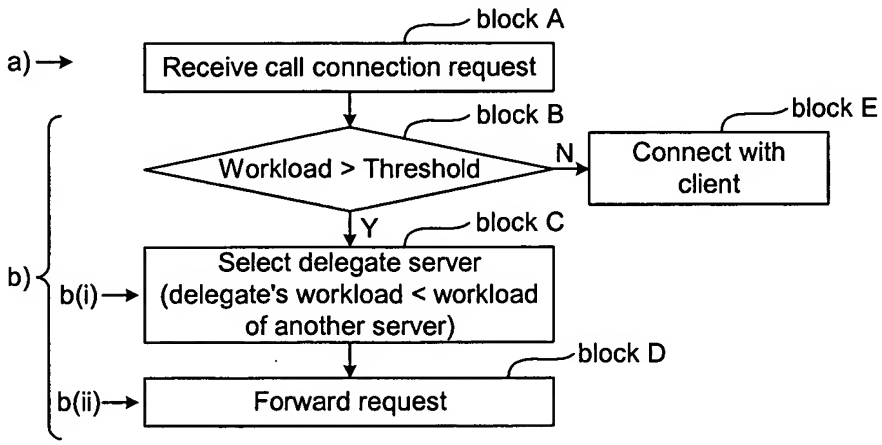
To assist the Pre-Appeal Brief Panel, a short explanation of the claimed method, the teachings of Kung, and how the claimed invention is not taught or suggested by Kung may be found at pages 5 and 6 of the Reply to Office Action Dated October 31, 2005 (Amendment after final filed December 27, 2005; paper number unknown).

To further assist the Pre-Appeal Brief panel, an explanation of the clear factual errors in the Advisory Action follow. While the Examiner's explanation is replete with

erroneous statements, only those statements having the most relevancy to the Pre-Appeal Brief Panel's consideration of this matter are addressed herein.

The Examiner clearly erred by stating that the workload level of the selected delegate VoIP proxy server to which the call request is forwarded must be less than the predefined workload threshold associated with the primary VoIP proxy server. This is not what is claimed. Rather, a primary VoIP proxy server's predetermined threshold is used to evaluate the ability of the primary VoIP proxy server to service the call. If the call cannot be serviced, the relative workloads of the other VoIP proxy servers are compared against one another to decide, at least in part, where to forward the call request. Therefore, the Examiner errs by comparing the workload of the potential delegate VoIP proxy servers with the predefined threshold.

To assist in understanding that which is claimed, the following flow chart is provided. The outline-style references appearing in claim 21 (e.g., "a)", "b(i)", etc.) have been added to the flowchart as guidance, as well as reference characters for each functional block. Claimed step c) is omitted from the flow chart for the sake of brevity, but step c) is instrumental in providing the daisy chain method of forwarding call requests. As claimed, the determination in functional block B is independent of the determination in functional block C.



Assumptions made by the Examiner are not correct. For instance, as claimed, the workload of the selected delegate VoIP proxy server need not be less than the predefined threshold of the primary VoIP proxy server. The Examiner erroneously states that the claimed approach "requires that the delegate be selected only if the workload level is less than some other server [and the workload] must necessarily be less than the 'predetermined threshold'." Again, there is no relationship between the threshold at which the primary VoIP proxy server will start to forward requests and the workload of the other servers.

The claimed approach selects a delegate VoIP proxy server that has a workload that is less than another VoIP proxy server, but not necessarily the lowest workload server. For instance, if the primary VoIP proxy server receives a request and has a workload exceeding that server's predefined threshold, steps b(i) and b(ii) are to be carried out. By way of example, if workload were measured as a percent capacity and if there are three possible delegate servers that respectively have workloads of 65%, 50% and 30%, the 50% loaded server could be selected under the claimed language. Reasons to select the 50% loaded server over the lowest workload server (the 30% loaded server in the example) may be that the 50% loaded server has a lowest associated cost, is geographically closer, has a higher quality of service (QOS) rating, etc. (see, e.g., the Application at page 10, lines 26-30).

As recited in step c), the selected delegate VoIP proxy server carries out step b) as if it were the primary VoIP proxy server. Accordingly, the selected delegate VoIP proxy server is responsible for carrying out that which is recited in step b), including a determination as to whether the selected delegate VoIP proxy server has a workload exceeding a predefined threshold. Continuing the foregoing example, if the 50% loaded server is selected and if the 50% loaded server's predefined threshold is 45%, then b(i) and b(ii) would be carried out by the 50% loaded server. However, if the predefined threshold were 90%, the 50% loaded server would connect with the client.

In sum, legal and factual errors have resulted in the improper and baseless maintenance of the rejections. It is submitted that the claims are patentable and notice to that effect is requested.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0988, our Order No. INMEP0105US.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

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